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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,537	11/19/2001	Bradley A. Myers	26495-4	4428

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BENESCH, FRIEDLANDER, COPLAN & ARONOFF LLP  
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EXAMINER
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ROBERTSON, DAVID

ART UNIT	PAPER NUMBER
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3623

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/05/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

09/992,537

Applicant(s)

MYERS, BRADLEY A.

Examiner

Dave Robertson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 19-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 19-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 6/13/2002.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Examining claims 1 and 19-25.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/7/2007 has been entered.

#### ***Response to Amendment***

3. Claims 2-18 are cancelled by Applicant's amendment of 2/7/2007.

#### ***Response to Arguments***

4. Applicant's arguments with respect to claims 1 and 19-25 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Walker et al (US Pat. 5,862,223). Walker discloses a method and system for matching information-seeking clients to qualified experts, managing all steps in the process from request to

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payment and evaluation. Walker is disclosed in the context of users seeking information from experts, an "Expert Exchange".

#### Claim 1

Walker teaches receiving a case from a client (column 7 from line 5, user submits a request for information from an expert); assigning an investigator (expert) to the case (column 7 from line 47, expert winning bid for case is assigned to case), including selecting investigator from a preferred list (column 8 from line 16 and from line 52; user specifies qualifications and references and selects from preferred list of experts; and column 14 from 25, Expert database maintains data including areas of expertise, ratings, price ranges and other information for preferential selection by user). Walker further teaches calculating a budget for the case (column 7 from 10, user enters range of budget; and column 9 from line 29, Exchange manages billing and payment system), and sending a notification to the investigator requesting acceptance (column 7 from line 47, "bidding" starts acceptance of offer to investigator to notification (column 8 from line 13). In Walker, the system performs as the case manager, including the matching, communicating, and managing of client request for information and the expert providing the investigative service.

#### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 19-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (US Pat. 5,862,223).

Claim 19

Walker teaches a web-enabled, computer system including client, investigator (expert), and case (user request) database system for receiving and storing client information and a case from a client (column 7 from line 5, user submits request for information from an expert); assigning an investigator (expert) to the case (column 7 from line 47, expert winning bid for case is assigned to case), including receiving case information and investigator information in a preferred investigator list (column 8 from line 16 and from line 52; user specifies qualifications and references and selects from preferred list of experts) and determining a match (column 7 from line 47, suitable experts identified); the assigning of the investigator based on the analyzing of the client, case, and investigator information stored.

Walker does not expressly disclose providing a geographic database, however, Walker teaches collecting physical location address information from the client (column 14 from line 42, end user database includes address) and from the investigator (column 14 from line 25, expert database includes physical address). While one of Walker's benefits is to allow geographically independent exchanges, for example, making available idle experts in Russia to answer questions from end users worldwide, still, coupled with the enablement of preferential search according to geographic information by physical location stored in the client and expert databases, Walker teaches examples

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of information sought with a geographic preference (e.g. Russian history on Catherine the Great). Given this suggestion of advantage, and the capability of matching by client-expert geographic (location) data, it would have been obvious to one of ordinary skill in the art at the time of the invention that such geographic information (physical location, address of the expert) would give credence to the expert's qualification to provide information about that region and that such inclusion of geographic information in the analyzing and assigning of experts based on location information would have provided added confidence in the result (e.g. a Russian history expert located in Russia). Therefore, Walker fairly suggests a geographic database storing client and investigator location information including location information for use in the analyzing of a match and assignment of an investigator to a client.

#### Claim 20

Walker teaches a system and method that accepts, stores, and *reviews* the submitted case in at least the reviewing of a submitted request for whether the question can be answered by available resources (information databases) other than submitting it to an expert (column 19 from top, review of user submission prior to sending to experts, through column 20 line 50).

#### Claim 21

Walker teaches calculating a budget for the case (column 7 from 10, user enters range of budget; and column 9 from line 29, Exchange manages billing and payment system), and sending a notification to the investigator requesting acceptance (column 7 from line 47, "bidding" starts acceptance of offer to investigator to notification (column 8

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from line 13), and further, Walker teaches payment features as a fully automated billing system (column 21 from line 64).

Claim 21

Walker teaches receiving, reviewing, processing, and communicating end user cases (requests) with specific information as to the case type profile included in the request (see for example, from column 16 line 62). Case requests are inherently "live", i.e. active, until such time as the request is satisfied or cancelled.

Claim 23

Walker teaches assigning an investigator (expert) to the case (column 7 from line 47, expert winning bid for case is assigned to case), including receiving case information and investigator information in a preferred investigator list (column 8 from line 16 and from line 52; user specifies qualifications and references and selects from preferred list of experts) and determining a match (column 7 from line 47, suitable experts identified).

Claim 24

Walker teaches both synchronous (column 26 from line 21) and asynchronous (column 16 from line 53) client to investigator communications.

Claim 25

Walker teaches end user selection of the investigator (column 8 from line 50).

8. Claims 1 and 19-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (US Pat. 5,862,223) in view of Marty Sems ("Hiring An Online Detective", Online Privacy, April 2000). Walker teaches as above. Sems reviews online

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investigative resources and tips and resources for finding and hiring detectives, focusing on the information providing aspects of investigative resources and services.

All Claims

In anticipation of argument to the effect that if supposing Walker alone does read on the claims above, but that Walker's "Expert Exchange" does not read on (private) "investigator" matching and managing:

Walker teaches or suggests all of claims 1 and 19-25 above, however, Walker does not expressly teach the matching of a case to a (private) *investigator*. Sems, however, teaches that a "private investigator is someone who looks for answers to your questions." (See page 2). Sems further teaches that answers to investigative questions are readily available from resources on the Internet and to skilled online detectives, from other resources for finding information of interest to clients. Given Walker, in view of Sems' suggestion that the Internet age "investigator" is an online sleuth, it would have been obvious to one of ordinary skill in the art at the time of the invention that Walker teaches a system capable of hiring such investigators and that in this use clients would find additional advantage in the features of Walker for performing such investigations in a confidential manner (see Cryptographic and Anonymous Embodiments, columns 30 and 33, respectively).



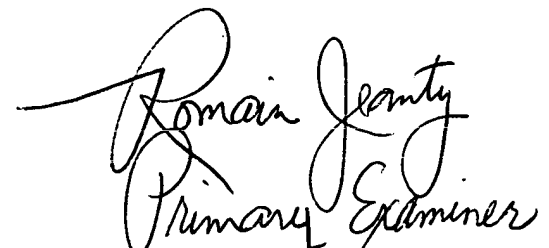
**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Robertson whose telephone number is 571-272-8220. The examiner can normally be reached on 8:15am to 5:15pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

dcr



Romain Jemty  
Primary Examiner  
Art Unit 3623